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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,235	03/08/2000	KISHORE S SWAMINATHAN	AND1P535	1907

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BRINKS HOFER GILSON & LIONE

P O BOX 10395

CHICAGO, IL 60610

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 02/10/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,235

Applicant(s)

SWAMINATHAN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication: Amendment filed 11/17/2003 to the original application filed 03/08/2000.
2. Claims 1-20 are currently pending in this application. Claims 1-2, 7-8, and 13-14 have been amended. Claims 19-20 have been added. Claims 1, 7 and 13 are independent claims.

Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 9-13, and 15-19 remain rejected under 35 U.S.C. 102(b) as being anticipated by **Kitain et al.** (U.S. 5,864,871 – filed 01/1997).

As to independent claim 1, Kitain teaches a method for developing a dossier, comprising the steps of:

- receiving a name of a client relevant to a proposal (*the user is required to provide ...the repository server will determine what information that user is authorized to receive; col.5, lines 63-67 / the web server can provide customized views ... to users; col.6, lines 43-61*);
- presenting a list consisting of industries associated with the client (*a list of companies and place the list in a form from which the user can choose a company; col.21, lines 36-38 / lists*

the industries that the user may choose ...industry groups 210; col.39, line40 – col.40, line 19 & Fig.3);

- allowing selection of an industry from the list of industries (*it lists the industries that the user may choose as selection criteria for documents; col.39, lines 1-67 & Fig.3);*

- searching for information relating to the client and the selected industry (*a list of the documents that fits certain user-specified search criteria ... match that search criteria; col.10, lines 46-54 & Figs.3-4); and*

- preparing the dossier utilizing the information found during the searching (*a list of the headlines of reports and items of corporate information ...reports that satisfy a user's query; col.46, lines 48-67 / query results listing research reports ...satisfying the query; col.47, lines 16-52 & Fig.7).*

As to dependent claim 3, Kitain teaches the steps of displaying topics associated with the client and allowing selection of at least one of the topics for insertion of information relating to the selected at least one of the topics in the dossier (*the page 100, displayed ...a list of reports and items of incorporated information ...the user can select a headline; col.47, lines 11-29 & Fig.7).*

As to dependent claim 4, Kitain teaches the dossier is arranged in sections according to people, documents, and projects (*Each report and item of corporate information is listed on a single line, with information about it; col.47, lines 11-29 & Fig.7).*

As to dependent claim 5, Kitain teaches the people section is arranged according to the number of documents and projects an individual has produced related to the client or industry (*Fig.7, items 704, 712 and col.7, lines 16-29).*

As to **dependent claim 6**, Kitain teaches the documents and projects sections are arranged chronologically (*Each report and item of corporate information is listed on a single line, with information about it including the time of submission of the report; col. 7, lines 16-29 & item 702 in Fig. 7*).

Independent claim 7 is directed to a computer program for implementing the method of claim 1, and is similarly rejected under the same rationale.

Dependent claims 9-12 include the same limitations as in claims 3-6, and are similarly rejected under the same rationale.

Independent claim 13 is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

Dependent claims 15-18 include the same limitations as in claims 3-6, and are similarly rejected under the same rationale.

Dependent claim 19, Kitain teaches searching for information relating to the at least one of the selected topics, and displaying the information related to the at least one of the selected topics (*col. 45, lines 1-46*).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitain et al.** (U.S. 5,864,871 – filed 01/1997) in view of **Danish et al.** (U.S. 6,327,588 – filed 10/2000 which is continuation of application # 09/384,303 – filed 08/1999).

As to dependent claims 2, 8 & 14, Kitain does not explicitly teach “presenting an alternate list consisting of industries not associated with the client.”

Danish teaches presenting an alternate list consisting of industries not associated with the client (*a list box 15 comprising alphabetical listbox entries; col.5, line 62-col.6, line 10*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Danish with Kitain because it would have provided the capability for identifying an item among a family of items based on selections of alternatives among features associated with the items.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitain et al.** in view of **Wical** (U.S. 6,240,410 – filed 05/1999).

Dependent claim 20, Kitain does not explicitly teach “arranged sections include displayed expanded node and subnodes.”

Wical teaches arranged sections include displayed expanded node and subnotes (*Abstract*).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Wical with Kitain because it would have provided the capability for ordering documents in a hierarchical structure that includes a plurality of hierarchical level based on pre-defined categories.

Response to Arguments

6. Applicants' arguments with respect to claims 1-20 have been considered but they are not persuasive.

Applicant argues that *Kitain is silent as to whether or not the industries may be associated with a specific company*. (Remarks, page 7, the last paragraph)

In response, Examiner believes that Kitain does teach the industries associated with the client (a list of companies and place the list in a form from which the user can choose a company; col.21, lines 36-78). According to Kitain's teachings, company must be associated with the user, so the user can choose a company to perform a search.

Applicant argues that *Kitain does not describe present an "alternative list of industries," as required by claim 2*. (Remarks, page 8, the last paragraph – page 9, the first paragraph)

In response, Examiner believes that Danish's teachings "a list box 15 comprising alphabetical listbox entries; col.5, line 62-col.6, line 10" reads the limitations as claimed by Applicant.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.


OFFICIAL faxes must be signed and sent to (703) 872-9306.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
February 6, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER